

The only ground of rejection is whether claims 1-20 are unpatentable over Walsh (U.S.P. 3,428,103)? Here it must be noted that Walsh was cited initially but not specifically applied.

In his answer, the Examiner responds to appellant's citation of cases showing that reopening of this case on the same art is improper and also that *res judicata* applies, by attempting to shift the burden of showing prior adjudication to appellant. In this response appellant reaffirms all of his previous arguments and includes them in this answer by reference. Specifically it should be noted that the Patent Office's own rules require the consideration of all the cited art, i.e. 37 C.F.R. § 1.104, which states that the Examiner shall make a thorough investigation of the available prior art. Also, since Walsh was cited initially it must have been considered. How would the Examiner cite a patent without considering what was disclosed in that patent? Thus, the burden is not on the appellant but is on the Examiner to show that the art he now considers important is better than the initially applied art.

Appellant believes that Walsh was not applied in the first instance because it is not particularly applicable, i.e.

not as pertinent as the initially applied art. For example, contrary to the Examiner's assertions, Walsh does not disclose a pouch "having substantially coextensive lips ... formed to provide a passive, non-sealing engagement between the lips" (appellant's claim 1). Walsh discloses a container 10 with "an opening in front 24" (Walsh spec., col. 2, line 41.) The opening has no lips but "is provided with a suitable closure such as a zipper 42." (Walsh spec., col. 2, lines 45-46.) The closure is provided "to permit sealing of article 40 within insulated container 10". (Accent added) (Walsh spec., col. 2, lines 44-45.)

It must be noted that there is no suggestion in Walsh that his container could be constructed without the closure (i.e. zipper 42). In fact, the closure was so important Walsh even included it in his one and only independent claim. Thus, to modify his container by removing the zipper or leaving it open (i.e. ignoring it) would render the container unsatisfactory for its intended use. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

It is most interesting to note that the Examiner is again arguing functional recitation, even though the Board of Appeals specifically dealt with this argument in its decision on the first appeal in the present prosecution (*res judicata?*). In his "new" argument the Examiner refers to cases dealing with "a claim drawn to a process of making", even though all twenty of appellant's claims are drawn to apparatus. However, putting aside this discrepancy *arguendo*, appellant believes that the Examiner's argument✓ is self defeating.

In his Answer, the Examiner states "a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim." and cites references to support this premise. However, this test fails conclusively. Appellant's claim 1 specifically states "lips being formed to provide a passive, non-sealing engagement between the lips". Walsh specifically discloses, illustrates, and claims an opening provided with a suitable closure such as a zipper 42 to permit sealing of article 40 within insulated container 10. (Walsh spec. col.

2, lines 44-46.) Thus, the container of Walsh is not capable of performing the intended use and does not meet the claim.

Appellant respectfully contends that, since claims 1-20 have structural differences and the container of Walsh cannot perform the intended use, the claims are patentable over Walsh. Accordingly, it is respectfully asserted that appellant's claims 1-20 are clearly allowable and the case is now in condition for allowance. Appellant therefore prays for the reversal of the final rejection and the allowance of the subject application.

Respectfully submitted,

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17 April 2006

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